



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1459
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,632	03/24/2004	John P. Jordan		4055

7590 03/31/2005
Richard D. Zimmerman
Chace Ruttenberg & Freedman LLP
Suite 300
One Park Row
Providence, RI 02903

EXAMINER

GREEN, BRIAN

ART UNIT PAPER NUMBER

3611

DATE MAILED: 03/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)
	10/807,632		JORDAN, JOHN P.
	Examiner		Art Unit
	Brian K. Green		3611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date, ____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date, ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Specification

The abstract of the disclosure is objected to because on line 4 legal phraseology “means” is used which is improper. Correction is required. See MPEP § 608.01(b).

Claim Objections

Claims 1-12 are objected to because of the following informalities: In claim 1, line 6, “the pockets” should be “the one or more pockets” to be consistent with line 5. In claim 3, the attachment means is formed by sonic welding, i.e. it is not “sonic welding”. In claim 4, the attachment means is formed by heat welding, i.e. it is not “heat welding”. In claim 10, line 2, “which angled portions” should be “the angled portions” to make it clear that the applicant is referring to the same angled portions defined on line 1. Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 is indefinite since it is not clear how the angled portions can make up part of the support line and still be at an angle to the support line.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4,6, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Berg et al. (U.S. Patent No. 5,620,271).

Berg et al. shows in figures 1,2, and 13 a storage page (10) comprising a back sheet (52) having a first side and a second side, a transparent first cover sheet (50), in which both the back sheet and first cover sheet are substantially rectangular and have substantially parallel long edges, parallel short edges, and a width and a height, the first cover sheet is attached to the first side of the back sheet by an attachment means (247-249,633,634,635) which forms attachment lines, the attachment lines forming one or more pockets between the first cover sheet and the first side of the back sheet, the pockets being sized to hold, at the user's option, either a standard size photograph or a standard size compact disc, the first cover sheet having a slit (230,231,232) for each pocket to allow insertion of a compact disc or photograph into each pocket, where each slit divides the first cover sheet into a large cover portion (the portion to the right of opening 230 and below the slit 232 in figure 13) and a small cover portion (the portion directly above the slit 232 in figure 13) for each pocket, and where each pocket has a support line (215) which has a gap (606), the gap sized to allow a compact disc to be positioned on either side of the support line by projecting through the gap. In regard to claim 2, Berg et al. shows in figures 1 and 2 a sheet that includes first and second cover sheets (50,51) attached to opposite sides of a base sheet (52). In regard to claims 3 and 4, Berg et al. discloses in column 13, lines 5-25 that the attachment lines are heat seals. Further, the method used to form the attachment means are not patentable features in an article claim, i.e. "sonic welding", "heat welding". In regard to claims 6 and 7, Berg et al. discloses the idea of placing printed/graphic information at least one of the pockets on each side of the sheet, see column 6, lines 25-27. The pocket which receives the printed/graphic

Art Unit: 3611

information is considered to be the memo area and the card in which the printed/graphic

information is attached is considered to be the card.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Hitchings (U.S. Pub.

No. 2004/0026278).

Hitchings shows in figures 1 and 2 a storage page (1) comprising a back sheet (3) having a first side and a second side, a transparent first cover sheet (9), in which both the back sheet and first cover sheet are substantially rectangular and have substantially parallel long edges, parallel short edges, and a width and a height, the first cover sheet is attached to the first side of the back sheet by an attachment means (13a-13c and see paragraph 0033) which forms attachment lines, the attachment lines forming one or more pockets between the first cover sheet and the first side of the back sheet, the pockets being sized to hold, at the user's option, either a standard size photograph or a standard size compact disc, the first cover sheet having a slit (33) for each pocket to allow insertion of a compact disc or photograph into each pocket, where each slit divides the first cover sheet into a large cover portion (the portion below the slit 33 in figure 1) and a small cover portion (the flap formed by slit 33) for each pocket, and where each pocket has a support line (23,25) which has a gap, the gap sized to allow a compact disc to be positioned on either side of the support line by projecting through the gap.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 and 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berg et al. (U.S. Patent No. 5,620,271).

In regard to claim 5, the examiner takes official notice that it is known to use hot melt glue to attach sheets together. It would have been an obvious matter of design choice to modify Berg et al. by using hot melt glue since the applicant fails to define any advantage to using hot melt glue and the heat sealing used by Berg et al. would work equally as well. In regard to claims 8,9,11, and 12, Berg et al. does not disclose the particular sizes defined in these claims. It would have been an obvious matter of design choice to modify Berg et al. to the dimensions defined by the applicant since the Federal Circuit has held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device, see *In Gardner V. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ (Fed Cir 1984), MPEP 2144.04, IV., A. In regard to claim 10, the applicant fails to define any advantage achieved by providing angled portions and the straight portions taught by Berg et al. would work equally as well.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hitchings (U.S. Pub. No. 2004/0026278).

Hitchings does not disclose the particular sizes defined in the claim. It would have been an obvious matter of design choice to modify Hitchings to the dimensions defined by the applicant since the Federal Circuit has held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device, see *In Gardner V. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ (Fed Cir 1984), MPEP 2144.04, IV., A.

Claims 2-5,8-10, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hitchings (U.S. Pub. No. 2004/0026278) in view of Berg et al. (U.S. Patent No. 5,620,271).

Hitchings discloses the applicant's basic inventive concept except for attaching a second cover sheet to the second side of the back sheet. Berg et al. shows in figures 1 and 2 a sheet that includes first and second cover sheets (50,51) attached to opposite sides of a base sheet (52). In view of the teachings of Berg et al. it would have been obvious to one in the art to modify Hitchings by attaching a second cover sheet to the second side of the back sheet since this would allow an additional disc to be held and displayed by the sheet. In regard to claims 3 and 4, Hitchings discloses in paragraph 0041 the idea of using thermal fusion, RF welding, sonic or thermal welding. In regard to claim 5, The examiner takes official notice that it is known to use hot melt glue to attach sheets together. It would have been an obvious matter of design choice to

modify Hitchings by using hot melt glue since the applicant fails to define any advantage to using hot melt glue and the welding used by Hitchings would work equally as well. In regard to claims 8,9, and 12, Hitchings does not disclose the particular sizes defined in these claims. It would have been an obvious matter of design choice to modify Hitchings to the dimensions defined by the applicant since the Federal Circuit has held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device, see In Gardner V. TEC Systems, Inc., 725 F.2d 1338, 220 USPQ (Fed Cir 1984), MPEP 2144.04, IV., A. In regard to claim 10, the applicant fails to define any advantage achieved by providing angled portions and the straight portions taught by Hitchings would work equally as well.

Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hitchings (U.S. Pub. No. 2004/0026278) in view of Berg et al. (U.S. Patent No. 5,620,271) as applied to claim 2 above and further in view of Youngs (U.S. Patent No. 5,588,527).

Hitchings in view of Berg et al. disclose the applicant's basic inventive concept except for attaching a memo area to the page. Youngs shows in figures 1-3 a page that includes a memo area (56) for receiving a card (24). In view of the teachings of Youngs it would have been obvious to one in the art to modify Hitchings by attaching a memo area to the page since this would allow information related to the article in the pocket to be displayed to observers of the page. In regard to claim 7, Youngs shows a card (24) with indicia which is placed within the memo area (56).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Green whose telephone number is (703) 308-1011. The examiner can normally be reached on M-F 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (703) 308-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


BRIAN K. GREEN
PRIMARY EXAMINER

Bkg
March 25, 2005